

**REMARKS**

Claims 1-7, 29, 30 and 51-58 are pending in this application, as claims 31-50 have been withdrawn by the Examiner. Claims 1 and 3 are the pending independent claims. By this amendment, claims 1, 3, 4 and 5 are amended, new claims 51-58 are added, and claims 31-50 are withdrawn from consideration by the Examiner as being directed to a non-elected invention.

Reconsideration in view of the above amendments and following remarks is respectfully solicited.

Entry of the amendment is proper under 37 CFR §1.116 since the amendment:

(a) places the application in condition for allowance (for reasons discussed herein); (b) do not raise new issue requiring further search and/or consideration (since the amendment amplify issues previously discussed throughout prosecution); (c) satisfy a requirement of form asserted in the previous Office Action; (d) do not present any additional claims without canceling a corresponding number of finally rejected claims; and/or (e) places the application in better form for appeal, should an appeal be necessary. Entry of the amendment is thus respectfully requested.

**Withdrawal of Claims 31-50 is Traversed**

Applicant respectfully traverses the withdrawal of claims 31-50 as being directed to a non-elected invention.

Applicant respectfully submits that the criteria for a proper restriction has not been met by the Examiner because the invention as disclosed in claims 31-50 is consistent with the group of claims identified by the Examiner and elected by the applicant, i.e., claims 1-7, 29 and 30, because each of the claimed inventions require *adding* information to the visible image, and thus no serious burden is created by the addition of claims 31-50.

As such, applicant respectfully requests consideration of all of claims 1-7 and 29-50.

**The Claims Define Patentable Subject Matter**

The Office Action rejects: (1) claims 3, 5 and 7 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,359,387 to Hicks (hereafter Hicks); and (2) claims 1-7, 29 and 30 under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,429,923 to Ueda et al. (hereafter Ueda).

These rejections are respectfully traversed.

Rejection under 35 U.S.C. §102(b)

Applicant respectfully submits that Hicks fails to teach or suggest each and every feature as set forth in the claimed invention.

For a Section 102 rejection to be proper, the cited reference must teach or suggest every claimed element. See *M.P.E.P. 2131; M.P.E.P. 706.02*. Thus, if a cited reference fails to teach or suggest one or more elements, the rejection is improper and must be withdrawn.

In this instance, Hicks does not teach or suggest each and every claimed element. For example, independent claim 3 recites, in part, "electronically recording inputted order conditions and processing conditions as order information onto the image recording medium on which the visible image is formed...". Hicks fails to teach or suggest this feature.

Instead, Hicks is directed towards printing a combined print and order form. The combined print and order form is delivered to the user and the user mechanically marks the order form to indicate the packages desired for each proof print. The order information contained on the form in Hicks merely allows the user to indicate the number and size of the photographic prints desired.

As such, Hicks fails to teach or suggest electronically recording order conditions onto the visible image recorded in the

image recording medium. Hicks merely mechanically enters the order information consisting essential of print size and number of prints on the order form, thereafter, an operator at the lab enters the order data into the computer data base 12. (see Hicks, col. 4, lines 16-26).

Again, Hicks only mechanically enters the order data consisting of the number of and size of prints desired on the print and the photographic lab merely enters the order information into the computer database, not on the visible image itself.

Thus, Hicks fails to teach or suggest at least the above-noted feature of independent claim 3. Therefore, independent claim 3 fails to be anticipated by Hicks.

Furthermore, dependent claim 5 recites that copy information is electronically recorded onto the new image recording medium and claim 7 recites that the new image recording medium is photographic printing paper. However, Hicks fails to teach or suggest copy information being electronically recorded on the photographic print itself.

For at least the reasons noted above, Applicant respectfully submits that Hicks fail to teach or suggest each and every feature as set forth in claims 3, 5 and 7 and requests withdrawal of the rejection of claims 3, 5, and 7 under 35 U.S.C. §102(b) based on Hicks.

**Rejection under 35 U.S.C. §102(e) based on Ueda**

Claims 1-7, 29 and 30 stand rejected under 35 U.S.C. §102(e) as being anticipated by Ueda. Applicant respectfully submits that Ueda fails to teach or suggest each and every feature as set forth claims 1-7, 29 and 30.

As noted above, if a cited reference does not teach or suggest all of the claimed features, the rejection is improper and must be withdrawn.

In this instance, independent claim 1 recites, in part, "electronically recording order information...onto one of the image recording medium on which the visible image is formed and an order information recording medium". Independent claim 3 recites a similar feature, as noted above. Contrary to the assertion in the Office Action, Ueda fails to teach or suggest the above-recited feature of independent claims 1 and 3.

In contrast to the present invention, Ueda is directed to a photographic processing system, in which the main objective is to prevent others from learning the personal information of a person ordering print processing. See column 1, lines 35-45; column 2, lines 1-6. Ueda achieves this objective mainly by separating the gathering of print processing request information from personal information gathering, the former being carried out in a fairly conventional manner by having the orderer to specify his or her

wishes with respect to print processing. See column 36, lines 43-52.

Furthermore, in Ueda the process of gathering personal information, such as a user's address and phone number, is performed separately. For example, the user may insert a credit card into a card reader, and personal information may be determined on the basis of the credit card. See column 38, lines 10-27. Alternatively, a user may insert a shopping chain card or a card with barcoded information thereon. See column 34, lines 7-18.

Whatever the process, Ueda requires that order information is always packaged as a header and **transmitted** to a server to be processed. See, e.g., column 37, lines 20-25; column 39, lines 23-32; column 42, lines 12-22. However, there is no teaching or suggestion in Ueda that the header information is ever stored on the visible image itself in an image recording medium, as recited in the presently claimed invention. Instead, Ueda suggests the opposite, because its objective is to enhance security by separating personal information from print processing request information.

As a result, independent claims 1 and 3 fail to be anticipated by Ueda. Since claims 2, 4-7, 29, 30 and 51-58 depend directly or indirectly from independent claims 1 and 3, these dependent claims also fail to be anticipated by Ueda for at least the reasons stated above with respect to independent claims 1 and 3.

As such, applicant respectfully requests withdrawal of the rejection of claims 1-7, 29 and 30 under 35 U.S.C. §102(e) based on Ueda.

**CONCLUSION**

All rejections raised in the Office Action having been addressed, it is respectfully submitted that the present application is in condition for allowance, and such allowance is earnestly solicited. However, should there be any outstanding matters that may be resolved by a telephone conference, the Examiner is invited to contact Carolyn T. Baumgardner (Reg. No. 41,345) at 703-205-8000 in an effort to expedite prosecution.

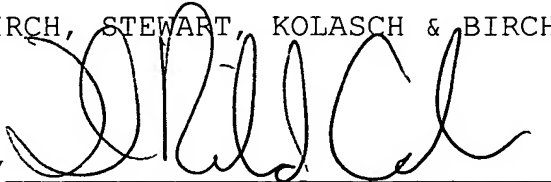
Applicant respectfully petitions under the provisions of 37 C.F.R. §1.136(a) and §1.17 for an one (1) month extension of time in which to respond to the Examiner's Office Action. The appropriate Extension of Time Fee is attached hereto.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§1.16 or 1.17, particularly extension of time fees.

Respectfully submitted,

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